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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/925,826	08/09/2001	Yuri Kazakevich	00167-428001	4667

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SMITH & NEPHEW, INC
1450 BROOKS ROAD
MEMPHIS, TN 38116

EXAMINER

LEUBECKER, JOHN P

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 06/02/2004

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/925,826

Applicant(s)

KAZAKEVICH, YURI

Examiner

John P. Leubecker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13, 14 and 16-26 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☒ Claim(s) 10, 11, 13, 14 and 16-26 is/are allowed.
6) ☒ Claim(s) 1-6 and 9 is/are rejected.
7) ☒ Claim(s) 7 and 8 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Claim Objections

1. Claim 1 is objected to because of the following informalities: in line 11, “pivoting” should be —pivot—to maintain consistent terminology. Appropriate correction is required.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1, 2, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoeg et al. (U.S. Pat. 6,371,909) in view of Thompson (U.S. Pat. 6,007,484).

The rejection appearing in numbered paragraph 2a of the previous Office Action, paper number 15, is hereby maintained. Applicant has amended claim 1 to include that the imaging probe is “detachably secured to the pivot mechanism”. Since most complex devices made of different parts and materials are usually assembled from separate parts and since it would not be reasonable to assume that all elements of the Hoeg et al. device shown in Figure 15 are made of a single integral piece, the Examiner takes the position that the imaging probe (130) would be inherently “detachable” by the same means that attaches it pivot mechanism (136). Applicant’s proposal that imaging probe (130) is “**permanently**” mounted to the endoscope is clearly not supported by evidence. However, it would also be obvious, if not inherent, to one of ordinary skill in the art to “detachably” attach the imaging probe to the pivot mechanism for the mere reason of allowing replacement of a defective imaging probe without discarding the entire device. This is a desirable feature and just makes sense.

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4. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoeg et al. in view of Thompson, as applied to claim 1 above, and further in view of Examiner's Official Notice, for the reasons set forth in numbered paragraph 2b of the previous Office Action, paper number 15. Although claims 4 and 5 were previously rejected separately, the Examiner takes the position that these claims describe obvious alternative actuating assemblies that are not new in the art of actuating assemblies and would be considered obvious in view of Hoeg's teaching to use other actuating assemblies (col.10, lines 29-36).

5. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoeg et al. in view of Thompson as applied to claim 1 above, and further in view of Wilk et al. (WO 93/15648) for the reasons set forth in numbered paragraph 2e of the previous Office Action, paper number 15. Placement of a transmitter in the imaging probe would eliminate the need for wires extending proximally through the endoscope from the imaging probe, thereby simplifying the operating of the pivot mechanism, eliminating any chance of entanglement with movement of the imaging probe, and allowing a reduction in diameter of the elongate member.

Allowable Subject Matter

6. Claims 10, 11, 13, 14 and 16-26 are allowed.

7. Claims 7 and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

8. Applicant's arguments filed March 12, 2004 have been fully considered but they are not persuasive.

The Examiner's rejections above address the newly added limitation to claim 1. Although Applicant argues that the imaging probes of Hoeg et al. and Thompson are "permanently" attached, it was found that there is no support or evidence in these references that the imaging probes were "permanently" attached.

Although claim 7 was rejected by the previous Examiner, this Examiner takes the position that such rejection is improper and hereby withdraws this rejection. This Examiner agrees with the previous Examiner that fluid conduits are notoriously well known to be used with endoscopes but only with fixed imaging probes. It would not be inherently obvious to provide a fluid conduit "positioned to discharge fluid on the objective lens of an image probe *that is arranged to move as claimed in claim 1*". Furthermore, there is no prior art of record that teaches such combination.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

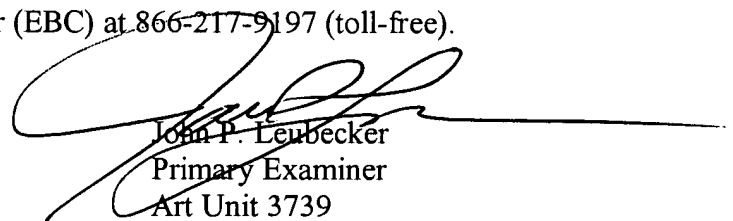
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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Leubecker whose telephone number is (703) 308-0951. The examiner can normally be reached on Monday through Friday, 6:00 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (703) 308-0994. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John P. Leubecker
Primary Examiner
Art Unit 3739

jpl